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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
3842-7

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on October 24, 2005

Signature: _____

Typed or printed name:

Application Number	Filed
09/788,402	February 21, 2001

First Named Inventor
BRÖNDRUP

Art Unit	Examiner
3629	J. OUELLETTE

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 35,329 (Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1,34 _____

Signature

Joseph S. Presta
Typed or printed name

703-816-4042
Requester's telephone number

October 24, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

BRÖNDRUP — Atty. Ref.: 3842-7; Confirmation No. 5430

Appl. No. 09/788,402 — TC/A.U. 3629

Filed: February 21, 2001 — Examiner: J. OUELLETTE

For: WIRELESS RESERVATION, CHECK-IN, ACCESS CONTROL, CHECK-OUT AND PAYMENT

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October 24, 2005

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

STATEMENT OF ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following identifies the clear errors in the Examiner's final rejection of pending claims 21-31 that was mailed on June 23, 2005.

In the June 23, 2005 Office Action, the Examiner rejected all pending claims (i.e., claims 21-31) for obviousness under 35 U.S.C. § 103(a). Specifically, claims 21-25 and 27-31 stand rejected based on the combination of the DeLorme '040 patent, the Pinzon '005 patent, and the Worcester article. (See June 23, 2005 Office Action, pp. 2-8). Claim 26 stands rejected based on the aforementioned references, together with the Martin '754

patent. (June 23, 2005 Office Action, pp. 8-9). The Examiner's reasons for the rejections are substantially the same as those made in the Office Action mailed October 12, 2004, which the Applicant responded to in its Amendment and Remarks filed on March 14, 2005.

Applicant submits that the substance of the June 23, 2005 Office Action (final rejection), fails to make a *prima facie* case of obviousness based on at least the failure of the Examiner to specify reasons as to why one of skill in the relevant art, if confronted with the same problems as the inventor and without knowledge of the claimed invention, would select the elements from the cited references and combine them in the manner claimed in the subject invention. Moreover, the references relied on by the Examiner do not, either alone or in combination, teach or suggest the limitations of the rejected claims, particularly those of independent claims 21 and 27.

A *prima facie* case of obviousness under 103(a) requires the Examiner to demonstrate that "'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" *In re Thrift*, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002) (quoting *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)). Because almost every invention is a combination of old elements, *In re Rouffet,* 47 USPQ2d 1453, 1457 (Fed. Cir. 1998), when a rejection under 103(a) is made, the Examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited

prior art references for combination in the manner claimed." *Id* at 1458. That is, the Examiner must "explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination" in a manner that would render the claimed invention obvious. *Id.* See also, *In re Lee,* 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). Such explanation is wholly absent from the Examiner's rejections in the instant case. Further, it appears that the Examiner inappropriately used the present application as a roadmap to select elements from different references in order to form the bases for the 103(a) rejections, without explaining why one skilled in the relevant art would be motivated to make such selection and combine the selected elements in a way that renders the application claims obvious. There is thus no adequate support for the selection and combination of the DeLorme, Pinzon and Worcester references such that claims 21-25 and 27-31 are rendered obvious. Similarly, there is no adequate support for the selection and combination of the DeLorme, Pinzon, Worcester and Martin references such that claim 26 is rendered obvious.

The lack of adequate support for the selection and combination of the cited references is further evidenced by the clear and unmistakable deficiencies of at least the DeLorme, Pinzon and Worcester references, which Applicant fully addressed at pages 8-11 of its March 14, 2005, Amendment and Remarks filed in response to the Examiner's October 12, 2004 Office Action. These deficiencies are such that the reliance placed on these references to support a 103(a) rejection is tenuous at best and would not lead one

skilled in the art to make the combinations advanced by the Examiner in the June 23, 2005 Office Action.

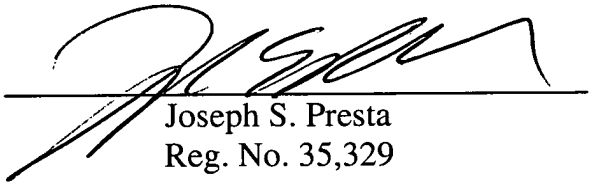
Moreover, as noted by Applicant in the March 14, 2005 submission at pages 8-11, several limitations of the rejected claims are not taught or even remotely suggested by any of the cited references. For example, none of the cited references either alone or in combination with any other cited reference teach or suggest a system in which an electronic key is obtained automatically and wirelessly, wherein said key is used to enable the user to automatically access an assigned hotel room without having to take any particular action such as pressing a predefined button on the user's wireless terminal, as required by independent claim 21. None of the references, alone or in combination, teach or suggest a system in which a computerized hotel reservation/IT system automatically and wirelessly communicates the electronic key to the remotely operable door lock associated with the assigned hotel room, as further required by independent claim 21. In fact, for the reasons stated at pages 8-11 in Applicant's March 14, 2005 submission, none of the cited references, even if properly combined, teach or remotely suggest the specific combination of features recited in independent claims 21 and 27. As such, the Examiner's obviousness rejections of claims 21 and 27 is untenable as there is no support for the obviousness rejections of these claims or the claims depending from them.

Based on the foregoing, Applicant believes that a pre-appeal brief review is appropriate to determine whether the Examiner has made a *prima facie* case of obviousness. Should this request be granted and a determination made that a *prima facie*

case of obviousness is supported by the Examiner's comments in the June 23, 2005, Office Action, Applicant submits that the remarks made in its March 14, 2005 filing sufficiently rebut the obviousness rejections. The remarks contained in Applicant's March 14, 2005 filing at pages 8-11 address the Examiner's previous rejections of claims 21-31 made in the October 12, 2004 Office Action, based on the same references presently at issue. As the substance of the October 12, 2004 rejections are substantially the same as those contained in the June 23, 2005 final rejections, Applicant believes that its March 14, 2005 remarks sufficiently rebut the final rejections of the June 23, 2005 Office Action.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

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